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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,239	08/03/2001	Cheryl Steed	4232/2	7541

7590

09/24/2003

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EXAMINER

PATTERSON, MARIE D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 09/24/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,239

Applicant(s)

STEED ET AL.

Examiner

Marie Patterson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 49-61 is/are pending in the application.
- 4a) Of the above claim(s) 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 49-57, and 59-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Election/Restrictions

1. Claim 58 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 49-57, and 59-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oakley (4864740) in view of Ogden (5388349) and/or Cintron (5675914) and Watt (4808458).

Oakley shows an insert comprising a synthetic non woven fabric layer (4), a non slip material (12, or coatings see column 3 lines 60-64), a material layer (10), and a surfactant on the fabric (column 3 lines 14-16) substantially as claimed except for the exact material for the synthetic non-woven fabric layer. Oakley states that the coefficient of friction for the bottom surface (16) of material (12) is greater than 170 (column 3 lines 40-45). Ogden teaches adjusting the coefficient of friction of a synthetic non woven top surface of an insert to above 0.5 (see column 11 lines 50-57). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the top having a coefficient of friction of between 0.52 and 0.82 which is above 0.5 as suggested by Ogden and within a common range of coefficients of friction

of commonly used insole materials (such as leathers, synthetic leathers, etc.), since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It would have been obvious to provide the top layer with a coefficient of friction of above 0.5 as taught by Ogden in the insert of Oakley to increase the feeling of control of the footwear. Also, Cintron teaches the well known and conventional use of suede materials for the top layers of inserts (column 3 lines 1-2). Watt teaches a specific suede-like material (i.e. fake suede, synthetic suede) which has vertically disposed fibers (18). It would have been obvious to use a suede material as suggested by Cintron and to use the synthetic suede-like material taught by Watt for the nonwoven layer of the insert of Oakley to provide a soft and comfortable feel.

Response to Arguments

4. Applicant's arguments filed 9/2/03 have been fully considered but they are not persuasive.

In response to applicants' argument that the material layer of Ogden is not a synthetic nonwoven, layer 4 of Ogden is synthetic (thermoplastic) material and it is nonwoven (not woven, it is extruded in sheet form, column 6 line 52). Ogden states that the vinyl acetate content of the thermoplastic material is variable to alter the coefficient of friction (column 6 lines 45-51) and clearly states that it is desirable to vary the coefficient of friction and teaches a coefficient of friction above 0.5 (column 11 lines 1-57). It would appear that it would have been obvious through discovery of workable ranges by one having routine skill in the art and as suggested by Ogden to merely raise

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the vinyl acetate content of the layer 20 to obtain a coefficient of friction of between 0.52 and 0.82 which are clearly above 0.5 and which is only a small amount above the 0.5 as suggested by Ogden to provide an enhanced feeling of control (as suggested by Ogden).

In response to applicants' arguments directed towards Cintron, Cintron has been merely used as a linking reference to show that it is well known and conventional to use suede like materials for the top of footwear inserts. Watt has been applied to show a specific suede like material. The material of Watt is clearly synthetic, nylon, polyester, polypropylene, etc. (see column 2 lines 15-20 and 40-50). Also, since this material is very similar if not the same material disclosed by applicant, i.e. a synthetic suede like material made with the vertical fibers being made from polyester or nylon fibers, the coefficient of friction of this material is considered to be inherently within the ranges claimed.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.

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A handwritten signature in black ink, appearing to read 'Marie Patterson', with a stylized flourish extending from the end.

Marie Patterson
Primary Examiner
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